

REMARKS

The Office Action

Claims 1-3, 7-8, 9-10, 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Farris, et al. (U.S. Patent No. 6, 233,313, hereinafter merely referred to as Farris) in view of Devine, et al. (Published U.S. Patent Application, Pub. No. 2004/0008724, hereinafter merely referred to as Devine).

Claims 4-6, 11 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Farris in view of Devine and in view of Nelkenbaum (U.S. Patent No. 6,751,297).

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Farris in view of Devine and further in view of Kouchri, et al. (Published U.S. Patent Application, Pub. No. 2004/0219911).

Comments/Arguments

The rejection of original independent claims 1 and 8 is hereby traversed. Significantly, claims 1 and 8 distinguish patentably over the prior art. That is to say, the references fail to teach each and every claimed feature. Moreover, the rejection is erroneous because there is improper and/or inadequate motivation to combine the references as proposed by the Examiner.

It is widely accepted that the initial burden of establishing a *prima facie* conclusion of obviousness rests with the Examiner. See, e.g., the Manual of Patent Examining Procedure (MPEP) §2142. In the present instance, the Examiner fails to establish a *prima facie* case of obviousness. Accordingly, the rejection of claims 1 and 8 is hereby traversed.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2142. Significantly, the combination of references in this case fail to teach or suggest all the claim limitations.

Moreover, the Examiner provides no suitable motivation for making the proposed combination.

When making a rejection under 35 U.S.C. §103, the Examiner is required to set forth in the Office Action: (i) the proposed modification of the reference necessary to arrive at the claimed subject matter, and (ii) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. See MPEP §706.02(j) (C) and (D). The Examiner in the present case sets forth neither of these requirements in the Office Action. Rather, the Examiner merely indicates that it would have been obvious to incorporate the teachings of Devine into Farris. See, e.g., Office Action page 3, first full paragraph. This merely conclusory statement is without any supporting evidence or rational, and inadequate to maintain a *prima facie* case of obviousness. Nowhere does the Office Action indicate with any specificity how Farris is being modified by Devine, nor is any motivation found in the references themselves for making the combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP §2143.01(III).

Additionally, the Examiner provides no suitable support for the obviousness rejection. That is, the motivation for any proposed combination is not expressly recited in the prior art. The Examiner’s statements in this regard simply lack any supporting evidence in the record.

Again, the MPEP is instructive on this point. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP §2143.01. Inasmuch as neither Farris nor Devine expressly provides the motivation for making the proposed combination, presumably the Examiner is relying on what is well-known prior art or common knowledge in the art.

Surely, the Examiner is well aware that the Applicant is required to seasonably challenge statements by the Examiner that are not supported by evidence on the record, and that failure to do so will be construed as an admission by the Applicant that the statements are true. See, e.g., MPEP §2144.03. Therefore, in accordance with the Applicant’s duty to seasonably challenge such unsupported statements, the Examiner is respectfully requested to cite one or more specific references that provide the motivation

for the proposed combination. Compliance with MPEP §2144.03 mandates that if an Examiner is to properly maintain a rejection then documentary evidence must be supplied when the Applicant traverses the Examiner's assertions with respect to what is well-known or common knowledge in the art. Alternately, if the Examiner is unable to provide the required evidence by way of a cited reference, and is instead relying on their own personal knowledge, Applicant hereby requests that the evidence be provided in the form of an affidavit from the Examiner under 37 C.F.R. §104(d)(2). Absent substantiation on the record by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. §103(a) be withdrawn.

Notwithstanding the inappropriateness of the combination, Farris in view of Devine still fails to teach all the claimed features. More specifically, the Office Action alleges that Farris teaches delivering call information to a designated law enforcement agency (LEA) – citing col. 9, lines 1-2. However, this is not what is being claimed. For example, claims 1 and 8 call for delivering “call content” to the LEA not “call information.” Clearly, call content is distinguishable from call information. Significantly, Farris does not teach the delivery of call content to an LEA in a packet-switched format. Moreover, neither does Devine. Rather, Devine merely discloses a gateway that bridges an Internet Protocol (IP) network (i.e., a packet-switched network) with a public switched telephone network (PSTN) (i.e., a circuit-switched network). That is to say, Devine does not teach the delivery of call content to an LEA. In this regard, the present claim invention proposes a significant departure from the prior art. That is to say, claims 1 and 8 call for delivering call content to an LEA in a packet-switched format. At best, Farris can be said to teach the delivery of call information to an LEA in a packet-switched format, and Devine can be said to teach the bridging together a circuit-switched network and a packet-switched network. Therefore, modifying Farris in accordance with the teachings of Devine still only suggests the delivery of call information to an LEA in a packet-switched format – not the delivery of call content to an LEA in a packet-switched format.

Accordingly, claims 1 and 8 distinguish patentably over the prior art, along with claims 2-7 and 9-15 that depend therefrom.

CONCLUSION

For the reasons detailed above, it is respectfully submitted that all the claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone the below signed, at the telephone number listed.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

April 5, 2006

Date

/John P. Cornely/

John P. Cornely

Reg. No. 41,687

1100 Superior Avenue

7th Floor

Cleveland, Ohio 44114-2579

(216) 861-5582

N:\LUTZ\200228\IEW0003575V001.doc